

REMARKS

Applicant respectfully requests entry and consideration of the above amendments even though presented after a final rejection. Applicant submits that the amendments do not raise new issues or require a new search. Further, entry and consideration of the amendments may isolate issues for potential allowance or appeal. The amendments were not presented earlier in the prosecution due to a better understanding of the Examiner's position as reflected in the latest Office Action.

Summary

Claims 1, 2, 4, 6-14, 16, 18-22, 24 and 26-28 stand in this application. Claims 3, 5, 15, 17, 23 and 25 have been previously canceled without prejudice or disclaimer. Claims 1, 10 and 21 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

35 U.S.C. § 103

At page 3, paragraph 4 of the Office Action claims 1, 2, 4, 6-14, 16, 18-22, 24 and 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Publication 2003/0228863 to Vander Veen et al. (hereinafter "Vander Veen") in view of United States Patent Number 6,819,304 to Branson (hereinafter "Branson"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 10 and 21 in order to facilitate prosecution on the merits. Support for the above amendments can be found at least in FIGS. 1 and 3 and accompanying text, such as the specification at page 11, lines 5-12, and page 13, lines 15-21.

To form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1, 2, 4, 6-14, 16, 18-22, 24 and 26-28. Therefore claims 1, 2, 4, 6-14, 16, 18-22, 24 and 26-28 define over Vander Veen and Branson whether taken alone or in combination. For example, claim 1 recites the following language, in relevant part:

a rigid display screen having a single physical size that is configurable between a first viewable physical size configuration and a second, larger, viewable physical size configuration.

Applicant respectfully submits that he has been unable to locate at least the above recited language of independent claim 1 in the teachings of the Vander Veen reference or the Branson reference.

Applicant respectfully submits that the Vander Veen reference fails to teach, suggest or disclose the above recited language of independent claim 1. As correctly noted in the Office Action, the Vander Veen reference fails to teach the above recited language of claim 1. Therefore, Applicant respectfully submits that the Vander Veen

reference fails to teach, suggest or disclose each and every element recited in amended independent claim 1.

Applicant respectfully submits that the Branson reference also fails to teach, suggest or disclose the above recited language of independent claim 1. Applicant respectfully submits that the Branson reference, arguably, teaches an adjustable display device having multiple display segments. In particular, the cited portions of the Branson reference, arguably, teach that the display device is made of a flexible material such as plastic polymer semiconductors that allow the physical dimensions of the adjustable display device to be modified by folding and unfolding, or attaching and detaching, the display segments. Branson, Col. 1: Lines 26-36 and Col. 3: Lines 42-50. By way of contrast, amended claim 1 recites “a rigid display screen having a single physical size that is configurable between a first viewable physical size configuration and a second, larger, viewable physical size configuration.” The Branson reference does not have “a single physical size,” but rather has different physical sizes depending on the number of display segments that are folded/unfolded or attached/detached. Applicant respectfully submits that he has been unable to locate at least the above recited language of claim 1 in the teaching of the Branson reference. Therefore, Applicant respectfully submits that the Branson reference fails to teach, suggest or disclose each and every element recited in independent claim 1. Consequently, the Vander Veen reference and the Branson reference, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

Furthermore, Applicant submits that even if the combination of the cited references were to teach or suggest every element of the claimed invention, without

motivation to combine the cited references to arrive at the claimed invention, a rejection based on obviousness under 35 U.S.C. § 103(a) is improper. *See* MPEP § 2143.01, for example. The motivation to make the alleged combination must be found either in the cited references or in the knowledge generally available to a person of ordinary skill in the art. *Supra*. Possible sources for a motivation to combine references include: (1) the nature of the problem to be solved; (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. The Office, however, cannot rely solely upon the level of skill in the art to provide the suggestion to make the alleged combination of cited references. *Supra*. Initially, the burden is on the Office to provide some suggestion that it is desirable to do what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *See* MPEP § 2142, for example.

Claim 1 is also patentable and non-obvious over the Vander Veen reference in view of the Branson reference, whether taken alone or in combination, because a rejection based on obviousness under 35 U.S.C. § 103(a) is improper without a motivation to combine the cited references. *See* MPEP § 2142, for example. The Vander Veen reference fails to discuss “a display screen having a single physical size that is configurable between a first viewable physical size configuration and a second, larger, viewable physical size configuration.” Therefore, the Vander Veen reference clearly fails to provide the proper motivation to make the combination alleged by the Office.

Similarly, the Branson reference fails to discuss voicemail applications in any context, let alone as recited in the claimed subject matter, and therefore also fails to provide the proper motivation to combine. Although both Vander Veen and Branson arguably relate to mobile devices, the Vander Veen reference is a mobile communications device while the Branson reference is a mobile display device, and therefore are non-analogous art.

In the present case, the Office Action has failed to meet its initial burden to provide some suggestion or motivation that it is desirable to do what the Applicant has done. The Office Action also has failed to support its conclusion of obviousness by failing to present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in view of the teachings of the cited references. To support its conclusion of obviousness, the Office Action states:

Using the adjustable display screen with the data adjustments of Branson on the interface of Vander Veen [such as Vander Veen, figure 15] would allow for a full set of icons corresponding to extended common functions to be displayed when all of the portions of the display screen are unfolded or attached, and displaying only some of the icons corresponding to basic common functions when portions of the display screen containing the icons are folded or removed. This would allow a user to flexibly select the size of the display area while maintaining the portability of the device.

Office Action, Page 12. The Office Action merely concludes that it would have been obvious to make the alleged combination without providing any reasoning as to why the alleged combination would have been desirable to a person of ordinary skill in the art. Rather, the Office Action states that “this would allow a user to flexibly select the size of the display area while maintaining the portability of the device.” This seems to be the

problem that the Branson reference is attempting to solve, and therefore would not seem to fairly suggest that incorporating a voicemail application to the Branson display device would be desirable, or vice-versa. As discussed previously, a conclusion by the Office that the claimed invention is obvious, either because it is expressly or impliedly suggested in the cited references, must be supported by a convincing line of reasoning setting forth why a person of ordinary skill in the art would have found the claimed invention to have been obvious in view of the teachings of the cited references. *See* MPEP § 2142, for example.

Here, the Vander Veen reference and the Branson reference fail to teach or suggest, either expressly or impliedly, the desirability of making the alleged combination to arrive at the invention of claim 1. Nor do the cited references provide any motivation to make the alleged combination to arrive at the invention of claim 1. Furthermore, the Office does not set forth a clear line of reasoning or suggestion as to why it would have been desirable for a person of ordinary skill in the art to make the alleged combination of the Vander Veen reference and the Branson reference, to arrive at the invention of claim 1. Without the benefit of the reasoning as to the motivation to combine the cited references, Applicant is unable to analyze the merits of the Office's reasoning.

Applicant further submits that the Office cannot rely on impermissible hindsight in combining the teachings of the cited references to arrive at the claimed invention. To reach a proper determination of obviousness under 35 U.S.C. § 103(a), the Office must reach its conclusion on the basis of the facts gleaned from the cited references. *See* MPEP § 2142, for example. Thus, to make a proper determination of obviousness under 35 U.S.C. § 103(a) the Office must take into account only knowledge that was within the

level of ordinary skill in the art at the time the claimed invention was made and does not include any knowledge gleaned from the Applicant's disclosure. *See* MPEP § 2145, for example. Here, Applicant respectfully submits that the Office's conclusion of obviousness is based on impermissible hindsight because the rationale provided by the Office Action appears to rely on the instant application rather than the cited references or level of ordinary skill in the art at the time the claimed subject matter was made.

To establish a *prima facie* case of obviousness, all of the teachings of the cited references must be considered, even disclosures that teach away from the claimed invention. *See* MPEP § 2141.02. Furthermore, the proposed combination cannot render the cited references unsatisfactory for their intended purpose or change the principle of operation of a reference. *See* MPEP § 2143.01, for example. Thus, it is improper to combine references where the references teach away from their combination. *See* MPEP § 2145, for example.

Here, the Branson reference teaches away from making the combination alleged in the Office Action because the Branson reference does not have any communications capabilities, and therefore would be unsuitable for voicemail applications as described by the Vander Veen reference. The display device of Branson appears to have computing capabilities to run applications, and in this respect is similar to a portable computer. Branson, Col. 4: Lines 42-56. The display device of Branson, however, does not appear to have any native communication capabilities, and therefore would seem to teach away from implementing the voicemail application taught by Vander Veen. Although the Branson reference briefly mentions that the display device has communication terminals designed to communicate with other devices, including mobile telephones and personal

digital assistants, these seem to be peripheral considerations. Therefore, it is improper to make the combination of the Vander Veen reference and the Branson reference as alleged in the Office Action.

For at least these reasons, Applicant submits that claim 1 is patentable over the cited references, whether taken alone or in combination. In addition, claims 10 and 21 recite features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claims 10 and 21 are not obvious and are patentable over the cited references for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 1, 10 and 21. Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 2, 4, 6-9, 11-14, 16, 18-20, 22, 24 and 26-28 that depend from claims 1, 10 and 21, and therefore contain additional features that further distinguish these claims from the cited references.

Conclusion

For at least the above reasons, Applicant submits that claims 1, 2, 4, 6-14, 16, 18-22, 24 and 26-28 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1, 2, 4, 6-14, 16, 18-22, 24 and 26-28 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-9338 to discuss any matter concerning this application.

Appl. No. 10/616,108
Response Dated August 21, 2008
Reply to Office Action of July 9, 2008

Docket No.: 1070P3823
Examiner: Tan, Alvin H.
TC/A.U. 2173

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to the credit card in the previously filed credit card authorization form.

Respectfully submitted,

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